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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,180	06/05/2001	Stephen William Colley	KPT 1090	5384

321 7590 02/27/2007

SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER	
MANOHARAN, VIRGINIA	
ART UNIT	PAPER NUMBER
1764	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/27/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Office Action Summary	Application No.	Applicant(s)	
	09/806,180	COLLEY ET AL.	
	Examiner	Art Unit	
	Virginia Manoharan	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Terminal Disclaimer filed on October 9, 2006 has been approved.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0151886 with or without Japan 5186392.

The above references are applied for the same combined reasons as set forth at page 5 of the previous Office Action.

Applicants' arguments filed October 9, 2006 have been fully considered but they are not persuasive.

Applicants' argument that "Both EP '892 (sic) and JP '392 fail to teach or suggest a process wherein a distillate comprising ethyl acetate, ethanol and not more than about 10 mol % water is recovered from a first distillation zone in a process to recover ethyl acetate from a feedstock comprising ethyl acetate, ethanol and water" is not considered well-taken. The above argued limitation is directed more to "result" rather than to any manipulative method or process step(s). This is admitted by applicants. Applicants assert that the "about 10 mol% water is a **surprising result** and one that is not suggested or taught by EP '892 (sic) and/or JP '392". (Emphasis added). However, the argued "surprising result" is not a prerequisite to patentability over the

reference process, and applicants may not be required to show surprising result. It is well-settled that a patent cannot be granted for an applicants' discovery of a result , even though it may be unexpectedly good , which would flow logically from the teaching of the prior art. Furthermore, if the evaluation of the invention as a whole is obvious, evidence of superior results does not preclude the finding of obviousness. In re Rau , 117 USPQ 215 (CCPA 1958) and In re Lindell, 155 USPQ 521 (CCPA 1967). It is clear from the teaching of the prior art that applicants contemplate doing what the prior art are doing. Compare claim 1 with EP '866 disclosures in page 11, lines 6-24; and in claim 10, page 26. Thus, contrary to applicants' allegation, EP '886 discloses the argued recovery scheme including a plurality of distillation stages. Applicants should delineate more the process/method steps not shown nor render obvious by the prior art. Furthermore, JP '392 discloses the concept of recovering ethyl acetate from a feedstock comprising ethyl acetate, ethanol and water, as in claim 1. Given that concept [In re Bascom, 230 F. 2d 612, 109 USPQ 98 (CCPA 1956)], one would have been led to modify EP '866 to include the argued water in the feedstock motivated by the reasonable expectation of success in the separation of the desired ethyl acetate; and since EP '886 suggests, page 14, lines 17-18 and 25, the presence of "water of known composition". The claimed specific result of "10 mol %" water is deemed of no patentable moment. The knowledge that water is present in known composition in the separation of ethyl acetate from a mixture containing the same by a distillative process, tells a person that an optimum amount exists. Finding this amount is of the essence within the purview of an artisan, resulting from an experimentation of an obvious nature. Nonetheless, one of ordinary skilled in the art would appreciate that the step of distillation would naturally or inherently removed any component e.g., the argued water, if

present, since distillation is a physical unit of operation based on boiling point characteristic that does not involve any chemical reaction.

> . Absolute predictability is not a prerequisite for obviousness rejection All that is required to show obviousness is that the applicant make his claimed invention merely by applying. knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the filed of his endeavor. See In re Winslow, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151 USPQ 48, 50-51 (1966). No commercial success is claimed, nor is any other factor indicating nonobviousness shown to exist.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 571-272-1450.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VIRGINIA MANOHARAN
PRIMARY EXAMINER
ART UNIT 1764